


Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 00-033	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 09/679,186	Filed October 3, 2000
on _____ Signature _____		First Named Inventor Jay S. Walker	
Typed or printed name _____		Art Unit 3714	Examiner Travis R. Banta
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.      33, 384 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p> Signature Stephan J. Filipek Typed or printed name 203-461-7252 Telephone number September 7, 2007 Date</p>	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> 1 *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Application No.: **09/679,186**  
Examiner: **BANTA, Travis R.**Customer No. **22927**  
Confirmation No. **7415****REMARKS AND ARGUMENTS**

Applicants respectfully request Pre-Appeal Brief Review of the rejections contained in the Final Office Action mailed April 9, 2007 (the "Final Action"). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

**A. Status of Claims**

Claims **40-74** are pending, and claims **40, 69, 70, 73 and 74** are independent.

Claims **40, 69, 70, 73 and 74** stand rejected under 35 U.S.C. §112, first paragraph, and claims **40-74** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schneier et al., U.S. Patent No. 5,871,398 (hereinafter "Schneier") in view of Nguyen, U.S. Patent No. 6,857,959 (hereinafter "Nguyen").

**B. Claim Rejection Under 35 U.S.C. §112, First Paragraph**

Independent claims **40, 69, 70, 73 and 74** stand rejected as failing to comply with the written description requirement.

The PTO's policy manual recites that the Examiner bears the burden of establishing a *prima facie* case of unpatentability for a Section 112, first paragraph, rejection (See MPEP 2163 (II)(A)). Evidence and reasoning must be provided to explain, by a preponderance of the evidence, why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. See In re Wertheim, 541 F.2d at 263, 191 USPQ at 97 (CCPA 1976). "The description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 169 USPQ 367, 370, 439 F.2d 220, 224 (CCPA 1971). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description." MPEP 2163 (III) (A). Thus, the proper inquiry is whether the specification

describes the claimed invention in sufficient detail so that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Appellants recognize that: “New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement.” MPEP 2163(I)(B)

In support of the Section 112, first paragraph, rejection, the Examiner asserts:

“...The amendment to these claims states “receiving from the player an indication, after receiving the total payout amount information...”. The specification teaches in many places that embodiments have been conceived of that allow the device to receive a player selection of an item before the total payout amount is received (see page 3 lines 20-23, 30-33, page 4 lines 3-7, 8-11, 16-20, 21-24, page 5 lines 4-7, 8-12, page 8 lines 18-26, page 10 lines 24-32 in reference to Figure 1). The example provided in page 13 of the specification shows an example of a player device receiving a total game outcome amount unbeknownst to the player prior to the player’s indication of a preferred item. Total payout amount as defined in the specification on page 8 lines 4-5 is defined as “the total money a player wins with respect to a total number of events”. The claims have been examined using this definition of “total payout amount”. The total payout amount is necessarily not received until at least after the player has made a selection because the player must make a selection of a preferred item before a decision of a win or a loss is made by the machine. For example, a player buys 5 tickets with determined outcomes \$0, \$2, \$6, \$0 and \$0. The player selects a book worth \$10. After the selection is made, the machine or merchant will decide whether \$10 is sufficient for the purchase of the book. It may or may not be. If it is, the total payout amount is the \$10 book. If it is not, the total payout amount is \$0 or \$8 depending on the embodiment. It is therefore impossible to determine a total payout amount before a player makes a selection of a preferred item according to the disclosure because the total payout amount (or value of the win) is unknown until the player makes a selection.” (Final Action, pages 2-3)

The Examiner apparently believes that claims **40, 69, 70, 73 and 74** do not enable one skilled in the art to determine the steps needed to arrive at the invention because “it is impossible to determine a total payout amount before the player makes a selection”. This statement is incorrect. The present specification does not prohibit a merchant from first receiving information regarding a total payout amount before a player indicates an item that the player wishes to win. While it is true that the cited example appearing on page 13, line 18 to page 14, line 10 describes an embodiment wherein a player indicates an item she wishes to win before the merchant accesses her PC to determine if her lottery outcomes are adequate, other embodiments

are described. In particular, an embodiment is disclosed wherein a merchant receives an indication that an item should be provided to a player based on information associated with the item and an outcome associated with a game event (see page 4, lines 29-31). There is no prohibition on the order in which the outcome and item information is received. Therefore, the outcome data may be received before the item information. In addition, the specification recites that the disclosed methods can be practiced in any order practicable, and performed by any described device (see page 30, lines 9-12). Accordingly, in some embodiments, one skilled in the art would understand that a merchant device could receive a total payout amount from a player device before receiving an indication of an item that the player wishes to win.

In view of the above remarks, Appellants respectfully assert that the specification as filed conveys with reasonable clarity that the applicants were in possession of the claimed invention as of the filing date of the application, which is the proper inquiry to be satisfied. Accordingly, the Examiner has not established a *prima facie* case of unpatentability, and thus we submit that the rejection of claims **40, 69, 70, 73 and 74** under 35 U.S.C. §112, first paragraph, cannot stand.

### **C. Claim Rejections Under 35 U.S.C. §103(a)**

Claims **40-74** stand rejected as being unpatentable over Schneier in view of Nguyen.

Schneier teaches a remote lottery system that enables players to purchase instant-type lottery game outcomes from a randomized prize data stream in a central computer, and view the outcomes on a gaming computer that does not require an on-line connection during play (see Schneier, Abstract, and col. 5, line 55 to col. 6, line 20). The Examiner admits that Schneier does not teach receiving an indication from the player of an item that the player is interested in winning, nor determining a value of the item, nor arranging for the player to receive the item (page 4 of the Final Action). Moreover, Schneier does not disclose receiving the indication of the item that the player is interested in winning after receiving total payout amount information that has not been disclosed to the player, as required by each of claims **40, 69, 70, 73 and 74**.

Nguyen discloses methods and gaming machines having a memory storing a list of prizes, a prize display, and a prize selection mechanism for a player to select a prize specific to one or more outcomes (Nguyen, col. 3, lines 28-35). The prize selection process begins before game play (and before any game outcome), such that the player “plays for the selected prize”

(for example, see the “name your prize” embodiment; col. 15, lines 3-24 and Fig. 7). Thus, the player selects one or more prizes connected to one or more possible game outcomes before initiating game play (see, for example, col. 4, lines 26-36; col. 7, lines 30-37; and col. 12, lines 8-11). One or more prizes are chosen, and the prize information could be stored on a magnetic card readable by a card reader. To start game play, the player inserts the magnetic card into a card reader, which reads the prize information and selects an appropriate pay table. The gaming machine then presents game outcomes, and if a specific game outcome corresponds to a selected prize payout, then the player wins his selected prize (col. 11, lines 27-61).

### C.1. Nguyen Teaches Away from the Present Claims

Nguyen’s system provides game outcomes after the player selects a prize or prizes to be awarded, which teaches away from the method of the pending claims. In particular, each of claims **40, 69, 70, 73 and 74** generally requires:

*receiving from a device information regarding a payout amount... stored on the device, wherein the payout amount has not been disclosed to a player, and receiving from the player an indication, after receiving the payout information and wherein the payout amount has not been disclosed to the player, of an item that the player is interested in winning.*

Thus, in accordance with the present claims, the game outcomes already exist at the time the player indicates an item that he is interested in winning. In an attempt to support the obviousness rejection, the Examiner has read a cited portion of Nguyen (col. 6, lines 60-64) out of context and incorrectly. In particular, the cited portion reads:

“Each of the prize selection tables 200 and 202 contains a number of prizes which a player may select as an award or pay-out when a certain outcome occurs during the course of a game being played on a gaming machine.” (Col. 6, lines 60-64).

Appellants submit that this sentence does not teach when the player makes a selection; it is simply a description of the prize selection tables. In addition, it is clear from the disclosure of Nguyen that follows this citation that the player first selects a prize which may be won when a jackpot occurs (col. 6, lines 65), and that the player uses the selection tables to select prizes when initiating a game on the gaming machine (col. 7, lines 1-2). Furthermore, Nguyen specifically teaches that the prize selection process usually begins before game play is initiated (col. 7, lines 30-31). Nguyen makes it clear that the point of providing the prize tables to players is to

encourage game play and to add excitement (col. 7, lines 53-57). Consequently, Nguyen systems and methods are distinct from that recited by the pending claims.

**C.2. No Evidence of Motivation to Combine Schneier and Nguyen**

Appellants respectfully submit that there is no teaching or suggestion in either Schneier or Nguyen (or otherwise supported by any evidence of record) to combine them. Although Nguyen mentions that the gaming machine may be a “lottery game”, it does not provide any indication of why one skilled in the art would combine Nguyen’s methodology with Schneier’s off-line remote system. Appellants respectfully assert that one skilled in the art would not consider Schneier’s system when attempting to solve the problem addressed by Nguyen, or vice-versa. Accordingly, the Examiner has failed to point out any teaching, suggestion or incentive in either Schneier or Nguyen for their combination.

**D. Conclusion**

In view of the above remarks, we respectfully request review and reversal of all of the Section 112 and 103(a) rejections of the pending claims.

Respectfully submitted,

September 7, 2007  
Date

/Stephan J. Filipek, Reg. No. 33,384/  
Stephan Filipek, Reg. No. 33,384  
Attorney for Applicants  
sfilipek@walkerdigital.com  
(203) 461-7252 /voice  
(203) 461-7018 /fax